

**REMARKS****I. Status of the Claims**

Prior to the Action, claims 5-39 were pending, and have been examined. Claims 10, 11, 34-37, and 39 have been cancelled herein without prejudice and without disclaimer, and Applicants further reserve the right to pursue claims of related or broader scope in one or more related application(s). Claims 5, 9, 33, and 38 have been amended herein without prejudice and without disclaimer, and Applicants reserve the right to pursue claims of related or broader scope in one or more related application(s). No new claims have been added.

Claims 5-9, 12-33, and 38 are therefore currently pending in the application.

**II. Support for the Amended Claims**

Support for the amended claims can be found throughout the drawings, specification, and claims as originally filed.

Claim 5 has been amended to include in the alternative the language from claims 9 and 10 as originally filed. Specific support for the amendments to claim 5 can be found at least in part in claims 5, 9, and 10 as originally filed.

Claim 9 has been amended to include the language from claim 10 as originally filed. Specific support for the amendments to claim 9 can be found at least in part in claim 10 as originally filed.

Claim 33 has been amended to include the language from claims 35 and 37 as originally filed. Specific support for the amendments to claim 33 can be found at least in part in claims 35 and 37 as originally filed.

Claim 38 has been amended to include the language from claim 39 as originally filed. Specific support for the amendments to claim 38 can be found at least in part in claim 39 as originally filed.

No new matter is included in the amended claims.

### **III. Rejection of Claim 36 under 35 U.S.C. §112, Second Paragraph**

The Action first rejects claim 36 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Action notes that the term “NCAM-positive cells” lacks antecedent basis in claim 34, from which claim 36 depends. The Action notes that Applicants’ intent was that claim 36 should depend from claim 35, which is correct. However, as Applicants have cancelled claim 36 herein without prejudice and without disclaimer, the present rejection has been rendered moot.

Applicants therefore respectfully submit that the rejection of claim 36 under 35 U.S.C. § 112, second paragraph, has been overcome; accordingly, the rejection should be withdrawn.

### **IV. Rejection of Claims 9-11 under 35 U.S.C. §112, First Paragraph**

The Action next rejects claims 9-11 under 35 U.S.C. § 112, first paragraph, as allegedly not enabled for the full scope of the claimed subject matter. Specifically, the Action alleges that: a) “(c)laims 9, 10, and 11 are drawn to the method of claim 5, wherein the differentiated neural cell population comprises at least about 60% dopaminergic neurons, 30% serotonergic neurons, and 25% oligodendrocytes, respectively”, and that “[a] single method cannot yield a

differentiated cell population that simultaneously meets the limitations of claims 9, 10, and 11, because the total comes to more than 100%” (the Action at page 3); and b) because FIG. 11 shows a differentiated cell population comprising approximately 28% oligodendrocytes, but NCAM-positive cells were not selected in FIG. 11, “the specification teaches that the method of claim 5 does not work to yield a differentiated cell population that comprises at least about 25% oligodendrocytes” (the Action at page 4). Applicants respectfully traverse.

Applicants respectfully point out that claims 9, 10, and 11 are independent of each other, and thus the percentages recited in these claims do not have to total 100% to be congruent with claim 5. In fact, each of claims 9, 10, and 11 could recite 100% and not conflict with each other or with claim 5. Furthermore, Applicants note that since the Action acknowledges that “Fig. 10 is congruent with claim 5 and supports claims 9 and 10” (the Action at page 3), and that claims 9 and 10 are allowable (the Action at page 7), claims 9 and 10 are clearly enabled. Therefore, while not acquiescing with the present rejection, since claim 11 has been cancelled herein without prejudice and without disclaimer, and the Action admits that claims 9 and 10 are enabled, the present rejection of claims 9-11 under 35 U.S.C. § 112, first paragraph, has been overcome.

Applicants therefore respectfully request that the rejection of claims 9-11 under 35 U.S.C. § 112, first paragraph, be withdrawn.

#### **V. Rejection of Claims 33 and 34 under 35 U.S.C. §102(b)**

The Action next rejects claims 33 and 34 under 35 U.S.C. § 102(b), as allegedly anticipated by Rolletschek *et al.*, *Mech. Dev.* **105**:93-104, 2001 (“Rolletschek”).

While not acquiescing with the present rejection, since claim 34 has been cancelled herein without prejudice and without disclaimer, and claim 33 has been amended to include the language of claim 37, which is not subject to the present rejection, and which the Action admits is allowable (the Action at page 7), the present rejection of claims 33 and 34 under 35 U.S.C. § 102(b) has been overcome.

Applicants therefore respectfully request that the rejection of claims 33 and 34 under 35 U.S.C. § 102(b) be withdrawn.

#### **VI. Rejection of Claims 5-8, 12-32, 35, 36, and 38 under 35 U.S.C. §103(a)**

The Action next rejects claims 5-8, 12-32, 35, 36, and 38 under 35 U.S.C. § 103(a), as allegedly being unpatentable over Rolletschek, and further in view of International Patent Application Publication No. WO 2001/88104, published November 22, 2001 ("Carpenter") and United States Patent Application Publication No. US 2002/0068045, published June 6, 2002 ("Reubinoff").

While not acquiescing with the present rejection, since claim 5 has been amended to include in the alternative the language of claims 9 and 10, which are not subject to the present rejection, and which the Action admits are allowable (the Action at page 7), claim 38 has been amended to include the language of claim 39, which is not subject to the present rejection, and which the Action admits is allowable (the Action at page 7), and claims 35 and 36 have been cancelled herein without prejudice and without disclaimer, the present rejection of claims 5-8, 12-32, 35, 36, and 38 under 35 U.S.C. § 103(a) has been overcome.

Applicants therefore respectfully request that the rejection of claims 5-8, 12-32, 35, 36, and 38 under 35 U.S.C. § 103(a) be withdrawn.

## VII. Conclusion

Applicants believe this Response to be fully responsive to all outstanding issues, and to place this application in condition for allowance. Reconsideration of the application and allowance of the pending claims is respectfully requested. If the Examiner has any questions or comments regarding any issue associated with this application, a telephone call to the undersigned representative at 512/542-8569 is welcome.

Respectfully submitted,



Margaret J. Sampson  
Reg. No. 47,052  
Attorney for Applicant

Vinson & Elkins L.L.P.  
First City Tower  
1001 Fannin St., Suite 2300  
Houston, Texas 77002-6760  
512.542.8569

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